

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : Cary Bates et al.  
Serial No. : 10/816,705  
Filed : April 2, 2004  
For : METHOD OF REMOTELY CONTROLLING SET TOP BOX  
VIA TELEPHONE, COMPUTER-READABLE STORAGE  
MEDIUM STORING INSTRUCTIONS FOR SAME AND  
APPARATUS USING A TELEPHONE INTERFACE  
Examiner : Jun Fei Zhong  
Group Art Unit : 2623

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450


PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

Applicants respectfully request a review of the final rejection in the above-identified application. No amendments are being filed with this request. This request is being filed with a Notice of Appeal. The review is requested for the reasons stated on the attached sheets.

Respectfully Submitted,

Dated: July 8, 2008  
Hawthorne, New York

  
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**ATTACHMENT TO PRE-APPEAL BRIEF REQUEST FOR REVIEW**

In the Final Office Action (dated Apr. 8, 2008), claims 1-5 and 12-14 were rejected under 35 U.S.C. § 102(b) as being unpatentable over U.S. Patent No. 5,671,267 to August et al. [hereinafter *August*]. Claims 6, 7, and 9-11 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *August* in view of various secondary citations that, as noted below, fail to cure the deficiencies of the rejection under 35 U.S.C. §102(b). The rejection of claim 1 is illustrative as to how the rejections are clearly not proper and are without basis.

**A. THE CLAIM REJECTION UNDER 35 U.S.C. § 102 IS CLEARLY NOT PROPER AND IS CLEARLY WITHOUT BASIS AS THE OFFICE ACTION COMPLETELY IGNORES THE TERM "EVENT" - A TERM EXPRESSLY RECITED IN EVERY INDEPENDENT CLAIM YET NOT FOUND IN THE CITED REFERENCE**

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Manual of Patent Examination Procedure* § 2131, (8th Ed. 2001) (Rev. 6, September 2007) (citing *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Id.* (citing *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989)). "The elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required. *Id.* (citing *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990)).

Claim 1 recites, inter alia:

controlling the set top box via at least one command transmitted by the calling party to the set top box during the telephone call, the controlling including directing the set top box to tune to a television event in accordance with the at least one command.

The Examiner contends that changing a changing a TV channel equates to "the controlling including directing the set top box to tune to a television event in accordance with the at least one command." Applicants respectfully disagree. To conclude otherwise would be to completely remove any patentable weight from the expressly recited claim term "event."

Further, even assuming *arguendo* that changing a channel *results in an event*, Applicants respectfully submit that tuning to an event is completely different. That is, tuning to a channel is completely different than tuning to an event. An event is not a channel even though an event may be carried by a channel, and a channel is not an event.

Applicants respectfully submit that the rejection is clearly not proper and is without basis. Accordingly, favorable reconsideration and withdrawal of the rejection under 35 U.S.C. § 102 are respectfully requested.

**B. THE CLAIM REJECTIONS UNDER 35 U.S.C. § 103 ARE CLEARLY NOT PROPER AND ARE CLEARLY WITHOUT BASIS AS THE SECONDARY CITATIONS FAIL TO CURE THE DEFICIENCIES OF THE REJECTION UNDER 35 U.S.C. §102(B) .**

Claims 6 stands rejected under 35 U.S.C. § 103(a) as unpatentable over *August* in view of U.S. Patent No. 6,772,436 to Doganata et al. Claim 7 stands rejected under 35 U.S.C. § 103(a) as unpatentable over *August* in view of U.S. Patent Publication No. 2005/0028208 to Ellis et al. Claims 9 and 10 stand rejected under 35 U.S.C. § 103(a) as unpatentable over *August* in view of

U.S. Patent No. 5,640,453 to *Schuchman*. Claim 11 stands rejected under 35 U.S.C. § 103(a) as unpatentable over *August* in view of U.S. Patent No. 6,219,355 to Brodigan. All rejections are respectfully traversed.

Each of the above secondary citations was applied against only various ones of the dependent claims. Applicants respectfully submit that none of these secondary citations add anything that would remedy the above mentioned deficiency in the primary citation to *August*. Thus, each of the proposed combinations of citations fails to disclose each and every feature of the claims.

Applicants respectfully submit that the rejections are clearly not proper and are without basis. Accordingly, favorable reconsideration and withdrawal of the rejections under 35 U.S.C. § 103 are respectfully requested.

#### CONCLUSION

For at least the reasons herein, Applicants respectfully submit that the rejections are clearly not proper, are without basis, and should be withdrawn. Further, Applicants respectfully request that the Office issue a finding that the application is allowed on the existing claims and that prosecution remains closed.

Respectfully Submitted,



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